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Ty Sagalow

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EXAMINER

GLASS, RUSSELL S

ART UNIT

PAPER NUMBER

3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/040,257

Applicant(s)

SAGALOW, TY

Examiner

Russell S. Glass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1, 3, 7, 8, 10, 12, 14-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer, (U.S. Pub. 2002/0116228) in view of Cianciarulo et al., (U.S. 6,922,720).**

2. As per claim 1, Bauer discloses a method for selling an insurance product online to a user, comprising the steps of:

- a. offering an online application to the user, the online application having a menu including a plurality of available insurance coverages, (Bauer, Fig. 3; ¶ 97, 101)(disclosing a menu optionally providing general coverage definitions for various types of coverages offered under the subject insurance plan),
- b. offering an online quote request form to the user in response to the user selecting a particular set of internet insurance coverages from the menu of available insurance coverages, (Bauer, Fig. 4; ¶ 102),

Art Unit: 3626

- c. upon the user completing the online quote request form for a particular set of internet insurance coverages, performing a risk analysis on the user, (Bauer, Fig. 4; ¶ 102),
- d. upon satisfactorily completing the risk analysis, offering an online quote for the particular set of internet insurance coverages to the user, (Bauer, ¶ 5, 102),
- e. upon the user accepting the online quote, selling the particular set of internet insurance coverages to the user, (Bauer, ¶ 101, claim 4).

Bauer fails to disclose a method for selling an internet insurance product including at least one of a first insurance coverage for advertising or marketing business conducted on the internet, a second insurance coverage for professional services rendered via the internet, a third insurance coverage for protection against a third party liability for business conducted on the internet; or any combination thereof, each of the available internet insurance coverages covering a plurality of the user's business transactions conducted online. However, such internet insurance coverage is well-known in the art as evidenced by Cianciarulo, (Cianciarulo, Abstract; col. 1, lines 22-52; col. 11, lines 3-11)(disclosing data transmission insurance related to marketing business services and professional services in the form of legal, financial, and healthcare services. Furthermore, the data transmission insurance is interpreted as including third party liability coverage because marketing and professional services all include third parties).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bauer and Cianciarulo. The motivation would have been to make

insure, bond and underwrite the electronic transmission of data, streaming data, and/or documents over the Internet, (Cianciarulo, col. 1, lines 16-18).

3. As per claim 3, Bauer discloses the wherein the risk analysis is performed online, (Bauer, ¶ 102, 103).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

4. As per claim 7, Bauer discloses the method wherein the user has access to specimen policies, (Bauer, ¶ 97).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

5. As per claim 8, Bauer discloses wherein the user has access to status information regarding his quote request, (Bauer, ¶ 22).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

6. As per claim 10, Cianciarulo discloses a fourth insurance coverage for network security when conducting business on the internet, (Cianciarulo, Abstract).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

7. As per claim 12, Bauer discloses a method further comprising the step of:
- f. upon the user completing the online application and before an online quote is offered to the user, offering an online self-assessment rating engine to the user, wherein the online quote request form is offered to the user upon the user completing an online self-assessment, (Bauer, Fig. 4; ¶¶ 102, 103).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

8. As per claim 14, Bauer discloses the claimed invention except for the step wherein the user is not required to provide authentication prior to receiving an online price quote. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the authentication step since it has been held that omission of an element and its function is obvious if the function of the element is not desired, (see MPEP 2144.04, citing *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989)).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

9. As per claims 15, 16, 18-20, these claims contain the same or similar limitations as claims 1, 3, 7, 8, 10, 12 and 14, and are therefore rejected on the same grounds, those grounds being incorporated herein by reference.

10. **Claims 2, 5, 6, 9, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the collective system of Bauer and Cianciarulo as applied to claim 1 above, and further in view of Luchs, ( U.S. 4,831,526).**

11. As per claim 2, the collective system of Bauer and Cianciarulo fail to disclose the method wherein the risk analysis is performed off-line.

However, such method is well-known in the art as shown by Luchs. Luchs discloses the method of claim 1 wherein the risk analysis is performed off-line, (Luchs, Col. 4, lines 44-60; Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65)(underwriting is considered risk analysis).

The motivation to combine Bauer and Cianciarulo is as provided in the rejection of claim 1 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the collective system of Bauer and Cianciarulo with Luchs. The motivation would be to retrieve or generate data to further define the risk, such data being reports, inspections, appraisals, quality control reports, and other risk-control measures. (Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65).

Art Unit: 3626

12. As per claim 5, the collective system of Bauer and Cianciarulo fails to disclose the method wherein the risk analysis includes an onsite security assessment of the user.

However, such method is well-known in the art as shown by Luchs. Luchs discloses method of claim 1 wherein the risk analysis includes an onsite assessment of the subject matter to be insured, such as an inspection, appraisal, or other risk-control measure, (Luchs, Col. 4, lines 44-60; Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65). It would be obvious to provide an onsite security assessment of electronic data if the subject matter to be insured was electronic data.

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.

13. As per claim 6, the collective system of Bauer and Cianciarulo fails to disclose the method wherein the onsite security assessment determines whether or not the user is approved for the online quote.

However, such method is well-known in the art as shown by Luchs. Luchs discloses the method of claim 5 wherein the onsite security assessment determines whether or not the user is approved for the online quote, (Luchs, Col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65).

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.



14. As per claim 9, the collective system of Bauer and Cianciarulo fails to disclose the wherein the user has access to a call center.

However, such method is well-known in the art as shown by Luchs. Luchs discloses the method of claim 9 wherein the user has access to a call center, (Luchs, Fig. 1; Col. 13, lines 64-68).

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.

15. As per claim 11, Luchs further discloses a method, further comprising issuing to the user an umbrella insurance policy comprising the particular set of internet insurance coverages sold to the user, (Luchs, col. 8, lines 28-30).

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.

16. As per claim 13, Luchs discloses a method wherein selling an internet insurance product online comprises issuing a new insurance policy, (Luchs, Fig. 2A)(disclosing a create new client function that is considered to include issuing a new insurance policy).

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.

Art Unit: 3626

17. As per claims 17 and 21, Luchs discloses a method wherein the user is a new customer, (Luchs, Fig. 2A)(disclosing a create new client function).

The motivation to combine Bauer, Cianciarulo and Luchs is as provided in the rejection of claim 2 and incorporated herein by reference.

### ***Response to Arguments***

Applicant's arguments filed 4/17/2007 have been fully considered but they are not persuasive of the following reasons:

1. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Bauer reference discloses the online application having a menu including a plurality of available insurance coverages, (Bauer, Fig. 3; ¶¶ 97, 101). The Cianciarulo reference discloses selling an internet insurance product including at least one of a first insurance coverage for advertising or marketing business conducted on the internet, a second insurance coverage for professional services rendered via the internet, a third insurance coverage for protection against a third party liability for business conducted on the internet; or any combination thereof, each of the available internet insurance coverages covering a plurality of the user's business transactions conducted online, (Cianciarulo, Abstract; col. 1, lines 22-52; col. 11, lines 3-11). Cianciarulo is interpreted as disclosing data transmission insurance related to marketing business services and

Art Unit: 3626

professional services in the form of legal, financial, and healthcare services.

Furthermore, the data transmission insurance is interpreted as including third party liability coverage because marketing and professional services all include third parties.

2. In response to applicant's argument that the Bauer and Cianciarulo are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references are both from the same field of invention as applicant because they both pertain to computer-implemented insurance business methods.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6/22/2007

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